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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,013	01/29/1999	YOICHI TAKARAGI	35.G2349	5593

5514 7590 10/18/2002

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NEW YORK, NY 10112

EXAMINER
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AHMED, SAMIR ANWAR

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/239013

Applicant(s)

YOICHI TAKARAGI

Examiner

S. Ahmed

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/21/02
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-8, 10-15, 17-19, 21-26, 28-40 is/are pending in the application.
- 4a) Of the above, claim(s) 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-15, 17-19, 21-26, 28-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/27/01 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other:  |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/21/02 has been entered.

2. Drawing changes filed 6/20/2001 have been approved.

3. Suspension granted 6/21/02 have been expired.

4. Applicant's arguments filed 5/22/02 have been fully considered but they are not persuasive with regard to claims 1, 8, 15, 19 and 26 for the following reasons:

As to claim 1, the Applicant alleges that “nothing in Funada teaches or suggests [.]” (page 3, line 18-page 4, line 4). The Examiner disagrees. Firstly, the color tone in Funada identifies particular kinds of originals such as securities, confidential patterns and the like (i.e., identification information), that cannot be copied based on that color tone (i.e., the color tone is related to copyright) which reads on that limitation as broadly claimed. Secondly, the Examiner cannot find in the claim language that the first identification information conveys information relating to copyright.

The Applicant alleges that “Both patents have to do with adding one mark [.]” (page 5, line 7-19). The Examiner disagrees. Funada teaches adding a particular pattern with yellow toner that is difficult to discriminate with human eye (one mark) upon detecting a color tone (different mark) on a document. The combination of the two references would be a system in which if the

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document is provided with a copyright mark not easily recognized with the eye that is provided by the Wen apparatus, a particular pattern that is difficult to discriminate with human eye is added to the document as taught by Funada. Funada is hiding the added particular pattern (the second information) because it is formed with yellow toner that is difficult to discriminate with human eye and the second information is added based upon the detection of the color tone (first information) as indicated above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 3-8, 10-15, 17-19, 21-26, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada (U.S. patent 5,257,119) in view of Wen (U.S. patent 5,822,660). The grounds for rejections stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 1, refer to claim 2 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 8, refer to claim 9 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

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As to new claim 15, refer to claim 16 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 19, refer to claim 20 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

As to new claim 25, refer to claim 26 rejection stated in paragraph 3 of the Office Action mailed on 12/20/00 paper number 5, are incorporated by reference herein.

7. This is a continuation of applicant's earlier Application No. 09/239013. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

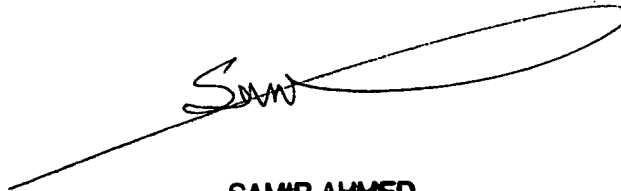
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Ahmed whose telephone number is (703) 305-9870. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for this Group is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SA

10/16/02

A handwritten signature in black ink, appearing to read 'SAHM', with a long, sweeping horizontal line extending to the left.

**SAMIR AHMED  
PRIMARY EXAMINER**